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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,505	03/19/2004	Rosa Cuberes Altisen	785-011733-US (PAR)	7668

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PERMAN & GREEN
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FAIRFIELD, CT 06824

EXAMINER

FREISTEIN, ANDREW B

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/804,505	ALTISEN ET AL.	
	Examiner	Art Unit	
	Andrew B. Freistein	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 11-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 23 is/are rejected.
- 7) ☒ Claim(s) 3,8-10 and 24-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/20/04, 8/22/05, 10/28/04, 1/9/06.</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-28 are pending in the instant application.

Priority

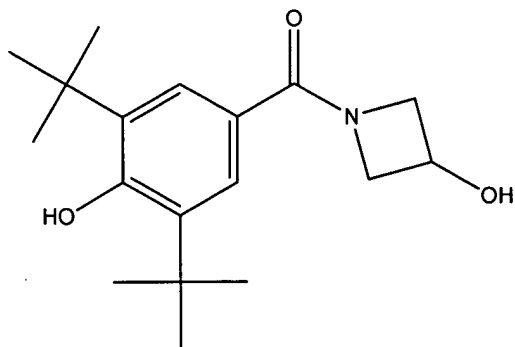
Acknowledgement is made of Applicant's claim for foreign priority under 35 U.S.C. § 119(a)-(d), by Spain patent application 00363 filed on 02/16/2004.

Information Disclosure Statement

Applicant's information disclosure statements (IDS), filed on 10/8/2004, 8/22/2005 and 1/9/2006, have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

Restriction Requirement

Applicant's election of Group I, claims 1-10, and the species (3, 5-di-tert-butyl-4-hydroxy-phenyl)-(3-hydroxy-azetidin-1-yl)-methanone,



, in the reply filed on 1/09/2006 has been entered.

Newly added claims 23-28 read on the limitations of claim 1 and are joined into Group I. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

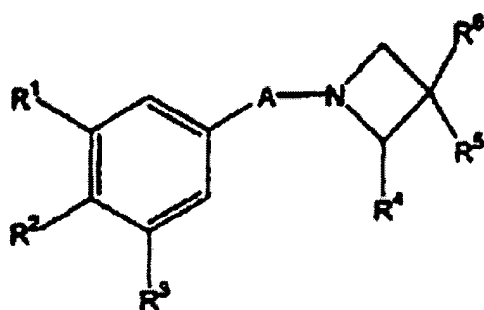
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

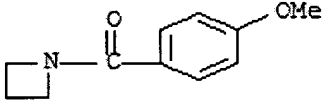
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4-7 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Otani et al., "An Evaluation of Amide Group Planarity in 7-Azabicyclo[2.2.1]heptane Amides. Low Amide Bond Rotation Barrier in Solution," J. Am. Chem. Soc., Vol. 125(49) pp. 15191-15199 (2003).

The instant application claims a substituted Azetidine compound of the formula



, wherein A is a –C=O moiety; R¹ is H; R³ is H; R² is C₁₋₃ alkoxy; and R⁴, R⁵, and R⁶ are each H. Claim 23 is drawn to compounds according to claim 1 where the stereoisomers are enantiomers or diastereomers.

Otani et al. disclose the compound  (see p. 15193, col. 1,

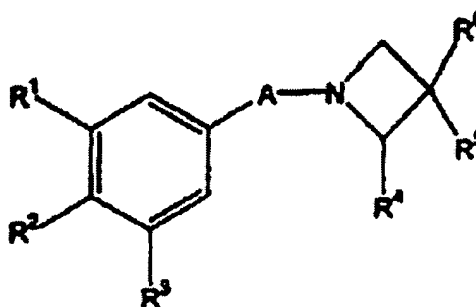
compound 7b). Otani et al. disclose the stereochemistry as enantiomers and diastereomers of the compound (see p. 15193, col. 1, Fig. 3 and Fig. 4).

Status of the Claims

Claims 1-10 and 23-28 (in part) are withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 CFR § 1.142(b). The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference that anticipates one invention would not render obvious the other invention.

Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



Compounds of the Formula I,

, wherein:

A is a -C=O-moiety;

R¹ is as defined in claim 1;

R² is a hydroxyl group, or a C₁₋₃-alkoxy group;

R³ is as defined in claim 1;

R⁴ is as defined in claim 1;

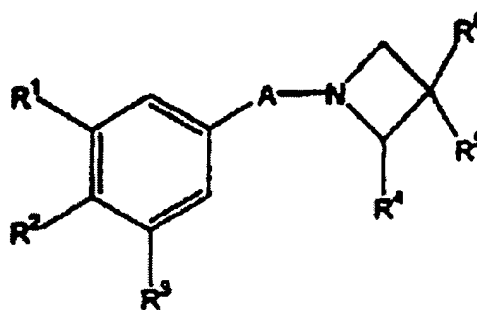
R⁵ is H, halogen, hydroxyl, or an aliphatic group;

R⁶ is H, halogen, hydroxyl, or an aliphatic group;

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Non-elected and Non-examined Subject Matter

The scope of the invention of the non-elected and non-examined subject matter is as follows:



Compounds of the Formula I, , wherein:

A is $-\text{CH}_2-$ moiety, $-\text{CH}_2-\text{C}=\text{O}-$ moiety, or $-\text{O}-\text{C}(=\text{O})-$ moiety as defined in claim 1;

R^2 is H;

R^5 is OR^7 , NH_2 , $\text{CO}-\text{NH}_2$, $\text{NH}-\text{CO}-\text{R}^8$, $\text{N}(\text{OH})-\text{CO}-\text{NH}_2$, $-\text{O}(\text{CH}_2)_{1-4}-\text{ONO}_2$, an aryl group, or a carboxy group; and

R^6 is OR^7 , NH_2 , $\text{CO}-\text{NH}_2$, $\text{NH}-\text{CO}-\text{R}^8$, $\text{N}(\text{OH})-\text{CO}-\text{NH}_2$, $-\text{O}(\text{CH}_2)_{1-4}-\text{ONO}_2$, an aryl group, or a carboxy group.

As a result of the election and the corresponding scope of the invention, identified supra, the remaining subject matter of Claims 1-10 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as NH_2 , $\text{CO}-\text{NH}_2$, $\text{NH}-\text{CO}-$, $\text{N}(\text{OH})-\text{CO}-\text{NH}_2$, $-\text{O}(\text{CH}_2)_{1-4}-\text{ONO}_2$, aryl groups, etc. which are chemically recognized to differ in structure, function, and reactivity.

Therefore, the subject matter which was withdrawn from consideration as being non-elected subject matter materially differs in structure and composition from the

elected/examined subject matter so that a reference which anticipates the elected/examined subject matter would not render obvious the non-elected subject matter.

Claim Objections

Claims 1, 4, 6-10 and 23-28 are objected to as being drawn to non-elected subject matter.

Claims 2, 3, 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the rejected base claim and any intervening claims.

Telephone Inquiry


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

for 

Andrew B. Freistein
Patent Examiner, AU 1626

Joseph K. McKane
Supervisory Patent Examiner, AU 1626
Date: February 6, 2006